

REMARKS

Originally filed claims 1 – 11 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, claims 1 – 11 were again rejected under 35 U.S.C. §112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable a person skilled in the art to make and/or use the invention; claims 3 – 5 and 11 were again rejected under 35 U.S.C. §112, second paragraph, as being indefinite; claims 1 – 8 were again rejected under 35 U.S.C. §102(b) as being anticipated by French patent no. 2,594,480 (hereinafter referred to as “the French ‘480 patent”); and claims 9 – 10 were again rejected under 35 U.S.C. §103(a) as being unpatentable over the French ‘480 patent.

By this Response and Amendment,

the specification has been amended to more adequately disclose tape housing 118 as depicted in originally filed figures 5 and 6 and to add reference number 9;

drawing figures 5 and 6 have been amended to add reference number 118;

claim 1 has been amended to recite “means for supporting said screen in its second position between one or more of said members of said canisters in their second position, comprising a metal tape having a arcuate cross section;” and, as amended the anticipation rejection thereto and the anticipation and obviousness rejections of the claims dependent thereon are traversed;

claims 1 – 11 have been amended to change “structure” to –device– so as to differentiate the word structure as used in claims 3 – 5; and

claim 11 has been amended to recite loops being formed on “top” levels of said canisters.

Support for the amendment to the specification can be found in original figures 5 and 6;

support for the amendment to claim 1 can be found on page 5, lines 9 – 12 of the original specification; and support for the amendment to claim 11 can be found in originally filed drawing figures 5 and 6. Therefore, it is respectfully submitted that the above amendments and corrections do not introduce any new matter to this application within the meaning of 35 U.S.C. §132.

Rejections Under 35 U.S.C. §112

1. 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 1 – 11 as containing subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Response

By this Response and Amendment, claim 11 has been amended to replace the term “bottom” with – top – as is depicted in originally filed drawing figures 5 and 6. And drawing figures 1 – 6 have been amended to add reference number 118 to the tape housing depicted in figures 5 and 6.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the outstanding rejections.

2. 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 3 – 5 and 11 as being indefinite.

Response

By this Response and Amendment, claims 1 – 11 have been amended to change the preamble term “structure” to –device– so as to differentiate the term “structure” as used in claims

3 – 5 and the term “patio” has been deleted from claim 5; and claim 11 has been amended to recite: “loops formed on said canisters at their top level to receive hooks of said screens.”

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the outstanding rejections.

Rejections Under 35 U.S.C. §102(b)

The Examiner rejected claims 1 – 8 as being anticipated by the French ‘480 patent.

Response

By this Response and Amendment, claim 1 has been amended to recite a “means for supporting said screen its second position... comprising a metal tape having an arcuate cross section.” As amended, the rejection to claim 1, and the claims dependent thereon, is traversed.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, or either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claim 1 of the present invention recites “[a] structure for supporting and erecting screens about an area to be shielded comprising canisters having a plurality of telescoping members, means for supporting said canisters in a generally vertical position, said members in a first position being at least partially retracted into its associated canister and in a second position

extended at least partially beyond the canisters, a screen roll containing a screen, said screen in a first position is retracted at least partially into said screen roll and in a second position extends out from said screen roll, and means for supporting said screen in its second position between one or more of said members of said canisters in their second position, comprising *a metal tape having a arcuate cross section.*” Present Application, claim 1, *emphasis added.*

All of the elements recited in amended claim 1 are not present in the prior art. Specifically, the French ‘480 patent does not disclose a privacy screen having a means for supporting the screen, the means comprising a metal tape having an arcuate cross-section. This element is simply not shown in the reference. As such, amended claim 1 is not anticipated by the cited prior art.

Accordingly, reconsideration and withdrawal of the outstanding rejections is respectfully requested. Also, as dependent claims contain all of the elements of the independent claims from which they depend, claims 2 – 8 are patentable over the cited reference for at least the same reasons as amended claim 1. Accordingly reconsideration and withdrawal of the outstanding rejections to claims 2 – 8 is also respectfully requested.

Rejections Under 35 U.S.C. §103(a)

The Examiner rejected claims 9 – 10 as being unpatentable over the French ‘480 patent.

Response

The arguments stated above with respect to the anticipation rejection of claim 1 are herein incorporated by reference.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that

some suggestion or motivation to modify a reference exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

The prior art does not teach or suggest all of the claim limitations of amended claim 1. Nowhere in the cited reference is a “means for supporting said screen in at least its second position... comprising a metal tape having a arcuate cross section” taught or suggested. At the most, the Examiner can infer that some structure maintains the cited prior art screen in an extended position; however, there is no express teaching or suggestion in the prior art to use a metal tape having an arcuate cross section to maintain the presently disclosed screen in an extended position.

Accordingly, as dependent claims contain all of the limitations of the independent claim from which they depend, and all of the limitations of amended claim 1 are not in the cited prior art, Applicant respectfully requests that the Examiner reconsider and withdraw the outstanding rejections to claims 9 – 10.

CONCLUSION


In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Respectfully submitted,

NATH & ASSOCIATES PLLC

Date: June 7, 2004
NATH & ASSOCIATES PLLC
1030 Fifteenth Street, N.W.
Sixth Floor
Washington, DC 20005
(202) 775-8383

By:



Gary M. Nath
Registration No. 26,965
Marvin C. Berkowitz
Registration No. 47,421
Derek Richmond
Registration No. 45,771
Customer No. 20529